

REMARKS

Applicant files the present Request for Continued Examination and requests a three month extension of time so as to present additional arguments and claims for consideration by the Patent Office, and for a more complete record should a future appeal be necessary.

Initially, Applicant amends claims 35 and 55 to correct typographical errors. No new matter is added. Applicant also adds new claims 56 and 57 that expand on the displaying step. Support for this can be found at page 10, lines 4-14 of the specification. New claim 58 provides an alternate recitation of claim 29, shifting the transmitting element to "receiving, at the fueling position, a service" over the network based on the customer response at the fueling position. No new matter is added. The total claim count is under twenty, with three independent claims, so no new fee for the new claims should be required.

Before addressing the rejections and the comments in the Advisory Action, Applicant provides a brief summary of the invention so that the remarks are considered in the proper context. The present invention is a system that is designed to provide multimedia content on the user interface of the fuel dispenser. The multimedia functionality is removed from the fuel dispenser by providing a thin client web browser on the fuel dispenser. With the thin client web browser, the fuel dispenser need not have substantial computing power to provide content to the user on the browser. In keeping with the thin client model, the browser on the interface prompts the user to request a service, receives the response, transfers the response to the server that will provide the service, and then receives the service based on the data from the server.

Rejection Under 35 U.S.C. § 103 – Hollidge

Claims 29, 30, 49, and 50 were rejected under 35 U.S.C. § 103 as being unpatentable over Hollidge. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located in the reference or combination of references. MPEP § 2143.03. If the Patent Office relies on a single reference, but the reference is missing a claim element, then the Patent Office must do two things in presenting its *prima facie* case of obviousness. First, the Patent Office must articulate a motivation to modify the reference to include the missing claim element, and second, the Patent Office must support the motivation to modify the reference with actual evidence. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Furthermore, if the Patent Office combines the reference

with another reference, the Patent Office must do two additional things. First, the Patent Office must articulate a reason to combine the references. Second, the Patent Office must support the motivation to combine with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). While this is similar to the standard for modifying a reference, the standards are distinct and must be addressed separately.

The Patent Office admits that Hollidge does not teach a web browser, but opines through the use of Official Notice that executing a web browser is old and well known in the internet website art. The Patent Office opines that it would be obvious to implement a web browser "for the advantage of efficiency in sales process by automating it." Applicant traverses for two reasons.

First, Applicant traverses the Official Notice. At the time of invention, namely, prior to July 1997, there was no general knowledge to incorporate a web browser into a fuel dispenser, nor was there any suggestion in the general knowledge of someone in the fueling industry to incorporate such technology into the fueling environment. The Patent Office opines that the personal computer exists at the PC 103 and the kiosk 115, and then opines that there is a link to the Internet based on the credit card authorization described at col. 22, lines 36-54. However, Applicant traverses the assertion that the Internet was used for credit card authorization in 1997 (i.e., the time of Applicant's filing). There is no evidence in the record that the Internet was used for credit card authorization in 1997. In fact, the telephone lines discussed in Hollidge at col. 22, line 41 reflect the common use of a dial-up modem to access a single secure server and pass sensitive credit card information over a secure line without exposing it to possible interception on the Internet. Pursuant to MPEP § 2144.03(C), Applicant requests that the Patent Office substantiate the Official Notice in the present case, and show that it was known to use the Internet for credit card authorization purposes at the time of filing.

Second, Applicant traverses the motivation to modify Hollidge based on the Official Notice. Even if the Official Notice is proper (a point Applicant does not concede), the Patent Office's use of the Official Notice is improper. While the Patent Office has articulated a motivation to modify Hollidge ("for the advantage of efficiency in sales process by automating it"), the Patent Office has not supported this motivation with the requisite actual evidence. Specifically, there is no evidence in the record outside of Applicant's disclosure that the sales process will increase efficiency through the use of a web browser. Absent the actual evidence, it

is improper to modify Hollidge in the manner suggested. Since it is improper to modify Hollidge to include a web browser, the Patent Office has not shown a claim element and has not established obviousness. Since the Patent Office has not established obviousness, claims 29, 30, 49, and 50 are allowable.

Claim 29 and 49 also recite that the web browser functions as a thin client. The Office Action of December 16, 2003 did not address this element. Applicant, in the response filed January 8, 2004, argued this element and presented evidence as to what "thin client" meant to someone of ordinary skill in the art, to assist the Patent Office in interpreting the term. The Patent Office responds by indicating that "applicant hypothecates '... as each fueling position 14 acts as a thin client ...' instead of stating position 14 in fact is a thin client" The basis for the rejection appears to be the use of the word "acts" in the specification. Presumably, because the fueling position merely "acts" as a thin client, the fueling position is not a thin client. Applicant respectfully points the Patent Office to the specification, page 9, lines 21-23, wherein the specification states that "adapting the dispenser to be a thin client is preferred" In this passage, the hypothecation of the previous passage is eliminated by usage of the verb "to be." Applicant does not hypothecate, and a rejection based on such an argument is not proper.

The Patent Office goes on to state in the Advisory Action that Hollidge teaches a thin client. Applicant respectfully traverses this assertion. Specifically, the Patent Office opines that "one server is present in fig. 13 (1307). It is connected to a card reader for payment (col. 2, L 44-55 and fig 15: visa) and establishes a thin client with off site application servers with its databases for handling credit card payment." Applicant notes that 1307 is software that is resident on the PC 103 (see col. 24, lines 50-65). Specifically, these software elements start when PC 103 is powered up (see col. 24, lines 65-70) and are contained within the PC 103 (see col. 25, lines 8-12). The fact that 1307 is labeled as a server relative to clients 1303 is indicative that 1307 is not a thin client, but rather performs substantive processing of the credit card authorization process. To this extent, since a fat client style software process is present on PC 103, the PC 103 is a fat client, and not a thin client. The processes running on PC 103 are not a thin client. While remote authorization for the credit card is secured, there is no evidence that this process is done through a thin client. As explained by the previously provided definition, the CPU processes must be done on a network server rather than a client computer to be a thin client. To the extent the Hollidge specifically contemplates the CPU processes being performed in PC

103, Hollidge does not contemplate a thin client model. If the Patent Office maintains this interpretation, then the Patent Office must present evidence that this process was a thin client process.

Even if the credit card authorization is done via a thin client (a point Applicant does not concede), the claim does not recite credit card authorization through a thin client; rather, the claim recites that a web browser executes as a thin client. Thus, the mere existence of a thin client in Hollidge is insufficient to establish obviousness, because the recited claim element has not been shown. If the Patent Office maintains that it would be obvious to modify the alleged thin client of the credit card authorization into the thin client web browser, then the Patent Office must articulate a motivation to make this modification, and further support this motivation with actual evidence. To date, the Patent Office has not done so, and the rejection of the claims is not proper.

Since the Patent Office has not shown where the thin client is present in Hollidge, or established the basis for combining the web browser into the Hollidge system, the Patent Office has not established obviousness, and claims 29, 30, 49, and 50 are allowable.

Rejection Under 35 U.S.C. § 103 – Hollidge & Craig

Claims 31-35 and 51-55 were rejected under 35 U.S.C. § 103 as being unpatentable over Hollidge in view of Craig. Applicant respectfully traverses. The standard for patentability is set forth above.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine Hollidge and Craig. Specifically, the Patent Office opines that it would have been obvious to implement the advertising feature “to increase sales revenue.” Applicant notes that this assertion is not supported by the required actual evidence. Since the motivation to combine the references is not properly supported, the references are not properly combinable. Since the references are not properly combinable, the Patent Office has not established obviousness, and the claims are allowable.

Applicant further traverses the rejection because the combination of references does not cure the deficiencies of Hollidge. Specifically, as discussed above, Hollidge does not teach the thin client or the web browser. Nothing in Craig cures the deficiencies of Hollidge. To this extent, even if the combination is proper (a point Applicant does not concede), the combination

does not teach or suggest all the claim elements, and the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, the claims are allowable.

Applicant further traverses the rejection of claims 32 and 52, wherein the Patent Office relies on Official Notice that it would be obvious to implement news, weather, sports, traffic updates, and maps. Nothing is present in the record that indicates that incorporating MAPQUEST into a fuel dispenser would have been obvious at the time of the invention. While www.mapquest.com was registered as a domain name in 1996, browsers were not present in fuel dispensers before Applicant's invention and thus, there is no evidence that it would be obvious to move such functionality into the fuel dispenser at the time of invention. Applicant requests substantiation of the Official Notice pursuant to MPEP § 2144.03(C).

Applicant further addresses a comment provided in the Advisory Action. Specifically, the comment in the Advisory Action states "on page 2 of the specification, second para., Gilbarco is not the inventor of US 5,602,745 or US 5,543,849." Applicant did not state that Gilbarco is the inventor of such patents. Gilbarco, the assignee of the present application, is also the assignee of the '745 and '849 patents. Therefore, the text on page 2, which states "See Gilbarco's U.S. Patent Nos. 5,602,745 . . . 5,543,849 . . ." is correct. Gilbarco is the owner of the patents, and thus the possessive recitation in the specification is correct. If the Patent Office needs proof of this statement, Applicant can provide such upon request.

Applicant requests reconsideration of the rejection and examination of the new claims. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

| |
|---|
| <p>CERTIFICATE OF TRANSMISSION I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING TRANSMITTED VIA FACSIMILE ON THE DATE INDICATED BELOW TO:</p> <p>Examiner: Wasylchak, S.R. Art Unit: 3624 Fax: 703-872- 9306</p> <p><u>REBECCA A. ROCKS</u> Name of Sender</p> <p><u>Rebecca A. Rocks</u> Signature</p> <p><u>9/16/04</u> Date of Transmission</p> |
|---|

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:

Steven N. Terranova
Steven N. Terranova
Registration No. 43,185
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: September 16, 2004
Attorney Docket: 2400-505